

3763 #
DFW

PATENT

Attorney Docket No.: D-10

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents,
P.O. Box 1450
Alexandria, VA 22313-1450

On Feb. 3, 2006
By [Signature]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
)
STEPHEN M. BRUNELL et al.)
)
Application No.: 09/293,231)
)
Filed: April 16, 1999)
)
For: SYSTEMS AND METHODS FOR)
ELECTROSURGICAL REMOVAL OF THE)
STRATUM CORNEUM)

Examiner: M. Mendez

Art Unit: 3763

**INFORMATION DISCLOSURE
STATEMENT AND
COMMUNICATION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The references cited on attached form PTO-1449 are being called to the attention of the Examiner. A copy of each is enclosed.

It is respectfully requested that the cited information be considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue there from.

The following information is being brought to the Examiner's attention.

I. LITIGATION ACTIVITY
Smith & Nephew litigation

On July 25, 2001, ArthroCare Corporation commenced an action in the United States District Court for the District of Delaware against Smith & Nephew, Inc. ("Smith & Nephew") for infringement of U.S. Patent Nos. 5,697,536 ("the '536 Patent"), 5,697,882 ("the '882 Patent") and

6,224,592 (“the ‘592 Patent”). That action was assigned Civil Action No. 01-504-SLR (the “*Smith & Nephew* litigation”). The *Smith & Nephew* litigation proceeded to trial commencing on April 30, 2003. On May 12, 2003, the jury returned a verdict in favor of ArthroCare on infringement and validity issues with respect to all three patents. A copy of the jury’s verdict, dated May 12, 2003, is enclosed. Thereafter, on June 20, 2003, the Court entered judgment on the jury’s verdict. A copy of the judgment is enclosed.

Numerous papers were filed with the Court during the *Smith & Nephew* litigation. The official docket kept by the clerk of the Delaware District Court, which is 43 pages long, is enclosed. The files holding the documents corresponding to the docket entries on the official docket span approximately eight linear feet of shelving space. Applicant is enclosing herewith the following documents from the *Smith & Nephew* litigation which show Smith & Nephew’s and Applicant’s primary arguments relating to issues of validity and enforceability:

1. Smith & Nephew’s Supplemental Responses to Plaintiff ArthroCare’s Interrogatories Nos. 4 And 5, dated December 19, 2001;
2. Smith & Nephew’s Supplemental Invalidity And Infringement Contentions, served March 29, 2002¹;
3. Smith & Nephew’s Supplemental Invalidity Contentions, served June 3, 2002;
4. Smith & Nephew’s Supplemental Invalidity Contentions, served September 10, 2002;
5. Smith & Nephew’s Supplemental Invalidity Contentions, served October 9, 2002;
6. ArthroCare’s Validity Contentions, served October 15, 2002;
7. Memorandum Order Re: Claim Construction, filed April 9, 2003;
8. Smith & Nephew’s Notice Pursuant To 35 U.S.C. § 282;
9. Trial Testimony Of Smith & Nephew’s Expert Dr. Kim Manwaring on May 6, 2003;
10. Trial Testimony Of Smith & Nephew’s Expert Dr. Kenneth Taylor on May 7 & 8, 2003;
11. Jury Verdict, dated May 12, 2003;
12. Judgment In A Civil Case, filed June 20, 2003;
13. Smith & Nephew’s Opening Brief In Support Of Its Inequitable Conduct Case, filed June 9, 2003;
14. Smith & Nephew’s Opening Brief In Support Of Its Rule 50(b) Motion For Judgment As A Matter Of Law, filed June 30, 2003;

1. Smith & Nephew marked its infringement contentions “Highly Confidential – Attorneys’ Eyes Only” under the protective order. Accordingly, Applicant has secured redacted pages that omit Smith & Nephew’s infringement contentions from this document.

15. ArthroCare's Corrected Answering Brief In Opposition To Smith & Nephew's Opening Brief In Support Of Its Inequitable Conduct Case, filed July 11, 2003²;
16. ArthroCare's Answering Brief In Opposition To Smith & Nephew's Rule 50(b) Motion For Judgment As A Matter Of Law, filed July 30, 2003;
17. Smith & Nephew's Reply Brief In Support Of Its Rule 50(b) Motion For Judgment As A Matter Of Law, filed August 14, 2003.

In addition to the above documents, a number of post trial motions were filed on the issues of infringement, invalidity, and inequitable conduct. In particular, Smith & Nephew filed a motion for judgment as a matter of law; a motion for a new trial; a cross motion to strike ArthroCare's motion for entry of judgment of no inequitable conduct and a motion to modify the protective order. ArthroCare filed a motion for entry of judgment of no inequitable conduct and a motion for a permanent injunction.

On March 10, 2004 the Court ruled in favor of ArthroCare on all post trial motions. The Court issued a 90 page memorandum opinion: 1.) denying Smith & Nephew's motion for judgment as a matter of law; 2.) denying Smith & Nephew's motion for a new trial; 3.) granting ArthroCare's motion for entry of judgment of no inequitable conduct; 4.) denying Smith & Nephew's cross motion to strike ArthroCare's motion for entry of judgment of no inequitable conduct; 5.) granting ArthroCare's motion for a permanent injunction; and 6.) denying Smith & Nephew's motion to modify the protective order.

The Court also issued, on March 10, 2004, a memorandum opinion granting ArthroCare's motion to dismiss Smith & Nephew's antitrust counterclaims.

The above mentioned memorandum opinions and corresponding orders are enclosed for your consideration.³

On June 9, 2004, the Court issued an order enjoining Smith and Nephew from directly infringing, inducing the infringement, and contributing to the infringement of the '536 Patent, the '882 Patent and the '592 Patent. The above mentioned memorandum opinions and corresponding orders are enclosed for your consideration⁴. Smith & Nephew has appealed the judgment and the injunction to the United States Court of Appeals for the Federal Circuit.

² Smith & Nephew's Reply Brief In Support Of Its Inequitable Conduct Case, dated July 24, 2003, was filed under seal by Smith & Nephew. If the Examiner requests a copy, Applicant will contact Smith & Nephew in an attempt to secure an agreement by which the brief can be disclosed.

³ A portion of the memorandum opinion discussing the antitrust issues has been redacted to preserve information that is confidential.

⁴ A portion of the memorandum opinion discussing the antitrust issues has been redacted to preserve information that is confidential.

On May 10, 2005, the Federal Circuit Court of Appeals issued a decision (attached) in connection with the lawsuit between ArthroCare and Smith & Nephew. In its decision, the Court, among other things, upheld the jury's verdict in favor of ArthroCare on U.S. Patent Nos. 5,697,882 and 6,224,592, but reversed the jury's verdict as to the validity of claims 46, 47, and 56 of U.S. Patent No. 5,697,536.

On May 23, 2005, Patentee filed a Combined Petition for Panel Rehearing and Rehearing *En Banc* (attached). The Petition specifies several points of law and fact overlooked or misapprehended by the Court of Appeals for the Federal Circuit in its May 10, 2005 Decision relating to the '536 Patent, the '882 Patent, and the '592 Patent. The Court issued an Order, dated July 12, 2005, denying Patentee's request for a panel rehearing and rehearing *En Banc*.

On September 2, 2005, ArthroCare and Smith & Nephew entered into a settlement agreement settling the legal disputes arising from the *Smith & Nephew* litigation. Attached is the Form 8-k, dated September 9, 2005, filed in connection with this material definitive agreement between ArthroCare and Smith & Nephew.

In addition to the above-listed materials, there are numerous other papers that were filed with the Court or served in connection with the *Smith & Nephew* litigation that relate to invalidity or enforceability issues. These include, for example, the expert reports of Dr. S. Nahum Goldberg (ArthroCare's expert on infringement and validity), Dr. Kenneth Taylor (Smith & Nephew's expert on infringement and invalidity), Dr. Kim Manwaring (Smith & Nephew's expert on invalidity), Dr. Michael Choti (Smith & Nephew's expert on infringement and invalidity), Charles Van Horn (ArthroCare's expert on patent prosecution issues), and Ronald Panitch (Smith & Nephew's expert on patent prosecution issues). Smith & Nephew also served a paper purportedly prepared by Dr. Brian Skromme of Arizona State University related to the validity of the '882 patent. Moreover, the parties filed motions for summary judgment on issues pertaining to the validity of the patents-in-suit. The briefs in support of and opposition to these motions are listed as docket numbers 247, 248, 257, 258, 261, 262, 280, 283, 292, 298, 300, and 302 on the official docket that ArthroCare has enclosed. Smith & Nephew also produced a declaration from Eberhard Roos, the named inventor on U.S. Patent No. 4,116,198 and co-author of the Roos and Elsasser article ("Über ein Instrument zur leckstromfreien transurethralen Resektion"), both of which were references asserted in the Smith & Nephew litigation. There also are many trial exhibits. In addition, pre-trial depositions were taken of several witnesses regarding validity and enforceability issues,

including depositions of Dr. Goldberg, Dr. Taylor, Dr. Manwaring, Dr. Choti, Mr. Van Horn, and Mr. Panitch. A list of the depositions taken in the *Smith & Nephew* litigation is set forth below:

1. John Tighe, taken September 18, 2002 and November 8, 2002 (ArthroCare employee, fact witness);
2. Diane DeLucia, taken September 19, 2002 (Smith & Nephew employee, fact witness);
3. John Raffle, taken September 19, 2002 and November 11, 2002 (ArthroCare employee and patent attorney, fact witness);
4. James Heslin, taken September 24, 2002 (patent attorney, fact witness);
5. Fernando Sanchez, taken September 24, 2002 (ArthroCare employee, fact witness);
6. Duane Marion, taken September 28, 2002 (former Smith & Nephew employee, fact witness);
7. John Graf, taken October 1, 2002 (Smith & Nephew employee, fact witness);
8. Hira Tahpliyal, taken October 1, 2003 and November 14, 2002 (co-inventor of patents-in-suit, fact witness);
9. Jim Pacek, taken October 3, 2002 and November 7, 2002 (ArthroCare employee, fact witness);
10. John Konsin, taken October 3, 2002 (Smith & Nephew employee, fact witness);
11. Jean Woloszko, taken October 3, 2002 (ArthroCare employee, fact witness);
12. Andrew Eggers, taken October 4, 2002 (employee of Eggers & Associates (owned by Philip E. Eggers, co-inventor of patents-in-suit), fact witness);
13. Bruce Prothro, taken October 4, 2002 (ArthroCare employee, fact witness);
14. Kara Weldon, taken October 5, 2002 (current or former Smith & Nephew employee, fact witness);
15. David Balford, taken October 5, 2002 (Smith & Nephew employee, fact witness);
16. Allen Weinstein, taken October 8, 2002 (ArthroCare employee, fact witness);
17. Christine Hanni, taken October 10, 2002 (former ArthroCare employee, fact witness);
18. Linda Guthrie, taken October 11, 2002 (Smith & Nephew employee, fact witness);
19. Michael Baker, taken October 11, 2002 (ArthroCare CEO, fact witness);
20. Kate Knudsen, taken October 11, 2002 and November 7, 2002 (Smith & Nephew employee, fact witness);
21. Sally Maher, taken October 11, 2002 (Smith & Nephew employee, fact witness);
22. Ron Sparks, taken October 11, 2002 (Smith & Nephew CEO, fact witness);
23. Philip E. Eggers, taken October 15 and 29, 2002, November 13, 2002, and April 30, 2003 (co-inventor of patents-in-suit, fact witness);

24. Tom Ross, taken October 15, 2002 (current or former employee of Oratec Interventions, Inc. (acquired by Smith & Nephew), fact witness);
25. Jack Cordes, taken October 15, 2002 (former employee of Eggers & Associates, fact witness);
26. Michael Long, taken October 29, 2002 (former Smith & Nephew employee, fact witness);
27. Joan McCreary, taken October 30, 2002 (Smith & Nephew employee, fact witness);
28. Todd Plevinsky, taken October 31, 2002 (former Smith & Nephew employee, fact witness);
29. Karen Drucker, taken November 1 and 14, 2002 (Smith & Nephew employee, fact witness);
30. Allen Gannon, taken November 1, 2002 (Smith & Nephew employee, fact witness);
31. Jim Pacek, taken November 7, 2002 (ArthroCare employee, fact witness);
32. Tim Crabtree, taken November 7, 2002 (former Smith & Nephew employee, fact witness);
33. John Konsin, taken November 7, 2002 (Smith & Nephew employee, fact witness);
34. Jason Krieser, taken November 13, 2003 (Smith & Nephew employee, fact witness);
35. Dr. Kim Manwaring, taken March 20, 2003 (Smith & Nephew expert witness);
36. Dr. Eliot Leitman, taken March 25, 2003 (ArthroCare expert witness);
37. Dr. Kenneth Taylor, taken March 27 and 28, 2003 (Smith & Nephew expert witness);
38. Dr. S. Nahum Goldberg, taken March 27 and 28, 2003 (ArthroCare expert witness);
39. Ronald Panitch, taken March 28, 2003 (Smith & Nephew expert witness);
40. Dr. Michael Choti, taken March 30, 2003 (Smith & Nephew expert witness);
41. Charles Van Horn, taken April 3, 2003 (ArthroCare expert witness);
42. Creighton Hoffman, taken April 4, 2003 (ArthroCare expert witness);
43. Brian Napper, taken April 17, 2003 (Smith & Nephew expert witness);
44. Warren Heim, taken April 22, 2003 (consultant to Smith & Nephew, fact witness).

Smith & Nephew designated many of the materials from the *Smith & Nephew* litigation as confidential pursuant to the protective order in that case. Without admitting the materiality or relevance of the foregoing materials, Applicant will submit any or all of the foregoing materials to the Examiner for consideration or, if the Examiner requests materials that have been filed under seal or designated confidential pursuant to the protective order, Applicant will contact Smith & Nephew in an attempt to secure an agreement by which such materials can be disclosed.

II. REEXAMINATION

A. The '536 Patent

On December 23, 1999, an *Ex Parte* Reexamination Request ("Request") for the '536 Patent was filed with the PTO. Applicant has enclosed a copy of the file history for the '536 Reexamination with this Information Disclosure Statement. The Request sought reexamination of claims 1-3, 14, 16, 22, 27, 30, 33, 38, 41-48, 55, 57, 60, and 63 of the '536 Patent in light of U.S. Patent 4,116,198 ("the Roos '198"). The PTO granted the Request on October 27, 2000.

On November 15, 2002, the PTO mailed an Office Action. The Office Action is divided into two sections. Section I sets forth the conclusion of the examiner and a board of primary examiners that "the Roos '198 does not anticipate or render obvious any of the independent claims of record." *See* November 15, 2002 Office Action at 3. Section II contains a rejection of claims 1-64 of the '536 Patent as anticipated under 35 U.S.C. § 102(b) and obvious under 35 U.S.C. § 103 in light of certain references identified in an Information Disclosure Statement filed by Applicant on June 19, 2002. On December 19, 2002, Applicant submitted a Response to the Office Action.

On March 14, 2003, the PTO issued a Notice of Intent to Issue *Ex Parte* Reexamination Certificate ("NIRC"). The NIRC states that "the examiner of record concurs with the arguments presented by patent Applicant on paper number 15. Accordingly, it is concluded that claims 1-64 are allowable over the prior art of record." *See* NIRC at 2. A Reexamination Certificate issued on June 10, 2003.

Additionally, on April 9, 2003, another *Ex Parte* Reexamination Request for the '536 Patent was filed with the PTO. The Request sought reexamination of claims 1, 2, 5, 9, 14, 15, 25, 26, 28, 30-33, 36, 38, 40, 42-47, 49, 53, 55, 56, 58, 59, 61, and 63 of the '536 Patent in light of the Roos '198; Elasser and Roos, "Uber ein Instrument zur leckstromfreien transurethralen resection," Medizinal-Markt/Acto Medicotechnica, Vol. 24, No. 4/1976, pp. 129-134 ("the Elasser and Roos article"); U.S. Patent Nos. 4,805,616; 4,674,499; 4,381,007; 5,217,459; and 5,007,908. The PTO granted the Request on June 30, 2003. It has been assigned Reexamination No. 90/006,597.

An Office Action issued on November 18, 2004. Applicant filed a timely reply on January 18, 2005.

B. The '882 Patent

On April 18, 2003, an *Ex Parte* Reexamination Request for the '882 Patent was filed with the PTO. The Request sought reexamination of claims 1, 13, 17, 18, 24, 26, 28, 29, 48 and 54 of the '882

Patent in light of U.S. Patent Nos. 5,122,138; 5,007,908; and Slager et al., "Vaporization Of Atherosclerotic Plaques By Spark Erosion," JACC Vol. 5, No. 6, June 1985:1382-6 ("the Slager Article"). The PTO granted the Request on July 1, 2003. It has been assigned Reexamination No. 90/006,607.

An Office Action issued on February 18, 2005. Applicant filed a timely reply on April 18, 2005

C. The '592 Patent

On April 21, 2003, an *Ex Parte* Reexamination Request for the '592 Patent was filed with the PTO. The Request sought reexamination of claims 1, 3, 4, 9, 11, 21, 23, 26, 27, 30, 32 and 42 of the '592 Patent in light of the Roos '198; the Elasser and Roos article; U.S. Pat. Nos. 4,381,007 to Doss; and the Slager Article. The PTO granted the Request on July 7, 2003. It has been assigned Reexamination No. 90/006,611.

An Office Action issued on April 14, 2005 and April 26, 2005. Applicant filed a timely reply on June 27, 2005.

Should the Examiner desire copies of any of the documents filed in connection with the above reexaminations Applicant will submit them upon a request to do so in writing from the Examiner.

III. CO-PENDING PATENT APPLICATIONS

The following is a list of co-pending applications:

Application No.	Filing Date	Application No.	Filing Date
09/293,231	16-Apr-1999	10/621,839	16-Jul-2003
09/314,247	18-May-1999	10/437,260	13-May-2003
09/338,842	23-Jun-1999	10/402,728	28-Mar-2003
09/347,390	06-Jul-1999	10/392,529	20-Mar-2003
09/354,835	16-Jul-1999	10/389,159	14-Mar-2003
09/372,454	11-Aug-1999	10/613,609	02-Jul-2003
09/457,201	06-Dec-1999	10/435,825	12-May-2003
		10/613,115	03-Jul-2003
09/501,327	09-Feb-2000	10/621,839	16-Jul-2003
09/512,742	24-Feb-2000	10/661,118	12-Sep-2003
09/562,496	01-May-2000	10/656,597	05-Sep-2003
09/586,295	02-Jun-2000	10/682,600	09-Oct-2003
09/679,394	03-Oct-2000	10/713,643	13-Nov-2003
09/747,311	20-Dec-2000	10/735,477	11-Dec-2003
09/796,094	28-Feb-2001	10/774,222	05-Feb-2004
09/839,427	20-Apr-2001	10/799,908	12-Mar-2004
09/963,736	03-May-2001	10/799,491	12-Mar-2004
		10/903,655	29-Jul-2004
10/072,599	05-Feb-2002	10/970,796	20-Oct-2004
10/097,763	13-Mar-2002		
10/139,117	03-May-2002	11/028,790	03-Jan-2005
10/187,733	27-Jun-2002	11/089,879	25-Mar-2005
10/264,308	02-Oct-2002	11/105,274	12-Apr-2005
10/288,227	04-Nov-2002	11/114,610	25-Apr-2005
10/290,930	07-Nov-2002	11/125,613	09-Mar-2005
10/290,930	07-Nov-2002	11/130,931	16-May-2005
10/291,213	08-Nov-2002	11/144,934	03-Jun-2005
		11/166,545	24-Jun-2005
10/339,470	09-Jan-2003	11/176,803	06-Jul-2005
10/367,608	13-Feb-2003		
10/372,591	21-Feb-2003		
10/374,411	25-Feb-2003		
10/384,050	05-Mar-2003		
10/389,159	13-Mar-2003		

Respectfully submitted,

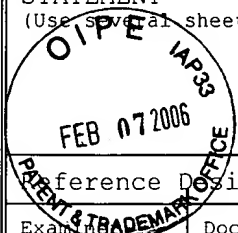
A handwritten signature in black ink, appearing to be 'R. Batt', written in a cursive style.

Richard R. Batt
Reg. No. 43,485

ArthroCare Corporation
680 Vaqueros Avenue
Sunnyvale, California 94085-3523
(408) 736-0224

FORM PTO-1449 (Modified) LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary)			Attorney Docket No. D-10		Application No.: 09/293,231	
			Applicant: Stephen M. Brunell et al.			
			Filing Date: April 16, 1999		Group: 3763	
Designation			U.S. PATENT DOCUMENTS			
Examiner Initial	Document No.	Date	Name	Class	Sub- class	Filing Date
FOREIGN PATENT DOCUMENTS						
	Document No.	Date	Country	Class	Sub- class	Translation (yes/no)
___ AN	57-57802	04/05/82	JP	A61B	1/00	
___ AH	97/48345	12/24/97	WIPO	A61B	17/39	
___ AI	98/27880	07/02/98	WIPO	A61B	17/39	
___ AB	92/21278	12/10/92	WIPO	A61B	5/04	
___ AC	94/08654	04/28/94	WIPO	A61M	37/00	
___ AD	97/00647	01/09/97	WIPO	A61B	17/39	
___ AE	97/00646	01/09/97	WIPO	A61B	17/39	
___ AJ	2 327 350	01/27/99	UK	A61B	17/39	
___ AK	2 327 351	01/27/99	UK	A61B	17/39	
___ AL	2 327 352	01/27/99	UK	A61B	17/39	
___ AA	0 694 290	11/15/00	Europe	A61B	18/04	
___ AF	0 703 461	03/27/96	Europe	G01R	27/02	
___ AG	0 754 437	01/22/97	Europe	A61B	17/39	
___ AM	3930451	03/21/91	Germany	A61B	17/39	
OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)						
___ AO	Pearce, John A. (1986) <i>Electrosurgery</i> , pgs. 17, 69-75, 87, John Wiley & Sons, New York.					
___ AP	J.W. Ramsey et al. <i>Urological Research</i> Vol. 13, pp. 99-102 (1985).					
___ AQ	V.E. Elsasser et al. <i>Acta Medico Technica</i> Vol. 24, No. 4, pp. 129-134 (1976).					
___ AR	P.C. Nardella (1989) <i>SPIE</i> 1068:42-49 Radio Frequency Energy and Impedance Feedback					
___ AS	R. Tucker et al., Abstract P14-11, p. 248, "A Bipolar Electrosurgical Turp Loop"					
___ AT	R. Tucker et al. <i>J. of Urology</i> Vol. 141, pp. 662-665, (1989).					
___ AU	R. Tucker et al. <i>Urological Research</i> Vol. 18, pp. 291-294 (1990).					
___ AV	Kramolowsky et al. <i>J. of Urology</i> Vol. 143, pp. 275-277 (1990).					
EXAMINER			DATE CONSIDERED			

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

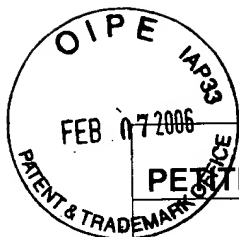
FORM PTO-1449 (Modified) LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary)			Attorney Docket No. <div style="text-align: center; font-weight: bold;">D-10</div>		Application No.: <div style="text-align: center;">09/293,231</div>	
<div style="position: relative;">  </div>			Applicant: Stephen M. Brunell et al.			
			Filing Date: April 16, 1999		Group: 3763	
Reference Designation			U.S. PATENT DOCUMENTS			
Exam Initial	Document No.	Date	Name	Class	Sub- class	Filing Date
FOREIGN PATENT DOCUMENTS						
	Document No.	Date	Country	Class	Sub- class	Translation (yes/no)
___ BK	57-117843	07/22/82	JP	A61B	17/39	
___ BL	99/51158	10/14/99	WIPO	A61B	17/39	
___ BM	99/51155	10/14/99	WIPO	A61B	17/36	
___ BF	97/48346	12/24/97	WIPO	A61B	17/39	
___ AW	95/34259	12/21/95	WIPO	A61F	5/48	
___ BN	98/27879	07/02/98	WIPO	A61B	17/36	
___ BE	97/24994	07/17/97	WIPO	A61B	17/39	
___ BD	97/24993	07/17/97	WIPO	A61B	17/39	
___ BO	97/24074	07/10/97	WIPO	A61B	17/39	
___ BC	97/24073	07/10/97	WIPO	A61B	17/39	
___ AX	93/13816	07/22/93	WIPO	A61B	17/36	
___ AY	90/07303	07/12/90	WIPO	A61B	17/39	
___ BG	98/07468	02/26/98	WIPO	A61N	1/40	
___ AZ	94/04220	03/03/94	WIPO	yes	A61N	
___ BB	96/00042	01/04/96	WIPO	A61B	17/39	
___ BH	2 308 979	07/16/97	GB	A61B	17/36	
___ BI	2 308 980	07/16/97	GB	A61B	17/36	
___ BJ	2 308 981	07/16/97	GB	A61B	17/36	
___ BA	0 740 926 A2	11/06/96	EP	A61B	17/39	
OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)						
___ BP	Kramolowsky et al. <i>J. of Urology</i> Vol. 146, pp. 669-674 (1991).					
___ BQ	Slager et al. <i>Z. Kardiol.</i> 76:Suppl. 6, 67-71 (1987).					
___ BR	Slager et al. <i>JACC</i> 5(6):1382-6 (1985).					
___ BS	Olsen MD, Bipolar Laparoscopic Cholecstectomy Lecture (marked confidential), 10/07/91					
EXAMINER			DATE CONSIDERED			

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

FORM PTO-1449 (Modified) LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary)		Attorney Docket No. D-10	Application No.: 09/293,231			
<div style="position: relative; height: 100px;"> <div style="position: absolute; top: 0; left: 0; width: 100%; height: 100%; border: 2px solid black; border-radius: 50%; text-align: center; color: white; font-weight: bold; font-size: 1.2em;"> TYPE FEB 07 2006 PATENT & TRADEMARK OFFICE </div> </div>		Applicant: Stephen M. Brunell et al.				
		Filing Date: April 16, 1999		Group: 3763		
U.S. PATENT DOCUMENTS						
Examiner Initial	Document No.	Date	Name	Class	Sub-class	Filing Date
FOREIGN PATENT DOCUMENTS						
	Document No.	Date	Country	Class	Sub-class	Translation (yes/no)
___ BU1	93/20747	10/28/93	WIPO	A61B	5/00	
___ BT	90/03152	04/05/90	WIPO	A61B	17/39	
___ BU	2313949	01/07/77	France	A61N	3/02	
OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)						
___ BV	Codman & Shurtleff, Inc. "The Malis Bipolar Electrosurgical System CMC-III Instruction Manual" 7/1991					
___ BW	Valley Forge's New Products, CLINICA, 475, 5, 11/6/91					
___ BX	Valley Forge Scientific Corp., "Summary of Safety and Effective Information from 510K," 1991					
___ BY	Codman & Shurtleff, Inc. "The Malis Bipolar Coagulating and Bipolar Cutting System CMC-II" brochure, early 1991					
___ BZ	L. Malis, "The Value of Irrigation During Bipolar Coagulation" See ARTC 21602, early 4/9/93					
___ CA	L. Malis, "Excerpted from a seminar by Leonard I. Malis, M.D. at the 1995 American Association of Neurological Surgeons Meeting," 1995					
___ CB	L. Malis, "Electrosurgery, Technical Note," J. Neursurg., Vol. 85, 970-975, 11/96					
___ CC	Ian E. Shuman, "Bipolar Versus Monopolar Electrosurgery: Clinical Applications," Dentistry Today, Vol. 20, No. 12, 12/01					
___ CD	Protell et al., "Computer-Assisted Electrocoagulation: Bipolar v. Monopolar in the Treatment of Experimental Canine Gastric Ulcer Bleeding," Gastroenterology Vol. 80, No. 3, pp. 451-455					
___ CE	Cook and Webster, "Therapeutic Medical Devices: Application and Design," 1982					
___ CF	Valleylab SSE2L Instruction Manual, 1/6/83					
___ CG	Robert D. Tucker et al., "Demodulated Low Frequency Currents from Electrosurgical Procedures," Surgery, Gynecology and Obstetrics, 159:39-43, 1984					
___ CH	Lu, et al., "Electrical Thermal Angioplasty: Catheter Design Features, In Vitro Tissue Ablation Studies and In Vitro Experimental Findings," Am J. Cardiol Vol. 60, pp. 1117-1122					
EXAMINER		DATE CONSIDERED				

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

FORM PTO-1449 (Modified) LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary)			Attorney Docket No. <div style="text-align: center; font-weight: bold; font-size: 1.2em;">D-10</div>		Application No.: <div style="text-align: center;">09/293,231</div>	
			Applicant: Stephen M. Brunell et al.			
			Filing Date: April 16, 1999		Group: 3763	
U.S. PATENT DOCUMENTS						
Examiner Initial	Document No.	Date	Name	Class	Sub- class	Filing Date
FOREIGN PATENT DOCUMENTS						
	Document No.	Date	Country	Class	Sub- class	Translation (yes/no)
OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)						
___ CH	Selikowitz & LaCourse, "Electric Current and Voltage Recordings on the Myocardium During Electrosurgical Procedures in Canines," <i>Surgery, Gynecology & Obstetrics</i> , Vol. 164, 219-224, March 1987					
___ CI	J. O'Malley, Schaum's Outline of Theory and Problems of Basic Circuit Analysis, McGraw-Hill, 2 nd Ed., 1992, pp. 3-5					
___ CJ	Arnaud Wattiez et al., "Electrosurgery in Operative Endoscopy," <i>Electrosurgical Effects</i> , Blackwell Science, pp. 85-93, 1995					
___ CK	Leslie A. Geddes, "Medical Device Accidents: With Illustrative Cases" CRC Press, 1998					
___ CL	Wyeth, "Electrosurgical Unit" pp. 1181-1202					
___ CM	C.P. Swain, et al., <i>Gut</i> Vol. 25, pp. 1424-1431 (1984)					
___ CN	Piercey et al., <i>Gastroenterology</i> Vol. 74(3), pp. 527-534 (1978)					
___ CO	A.K. Dobbie <i>Bio-Medical Engineering</i> Vol. 4, pp. 206-216 (1969)					
___ CP	B. Lee et al. <i>JACC</i> Vol. 13(5), pp. 1167-1175 (1989)					
___ CQ	K. Barry et al. <i>American Heart Journal</i> Vol. 117, pp. 332-341 (1982)					
___ CR	W. Honig <i>IEEE</i> pp. 58-65 (1975)					
___ CS	Jacob Kline, <i>Handbook of Biomedical Engineering</i> , Academic Press Inc., N.Y., pp. 98-113, 1988					
___ CT	M.B. Dennis et al. "Evolution of Electrofulguration in Control of Bleeding of Experimental Gastric Ulcers," <i>Digestive Diseases and Sciences</i> , Vol. 24, No. 11, 845-848					
___ CU	Letter from Department of Health to Jerry Malis dated April 15, 1985					
___ CV	Letter from Jerry Malis to FDA dated July 25, 1985					
___ CW	Letter from Department of Health to Jerry Malis dated 04/22/91					
___ CX	Leonard Malis, "Instrumentation for Microvascular Neurosurgery" <i>Cerebrovascular Surgery</i> , Vol 1, 245-260, 1985.					
___ CY	Valleylab, Inc. "Valleylab Part Number 945 100 102 A" Surgistat Service Manual, 7/88					
___ Cz	Leonard I. Malis, "New Trends in Microsurgery and Applied Technology," <i>Advanced Technology in Neurosurgery</i> , 1-16, 1988					
EXAMINER			DATE CONSIDERED			

**PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)**

Docket No. D-10

In re Application of: S. Brunell et al.

Application Number: 09/293,231

Filed: April 16, 1999

For: Systems and Methods for Electrosurgical Removal of the Strata Corneum

Group Art Unit: 3763

Examiner: M. Mendez

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.

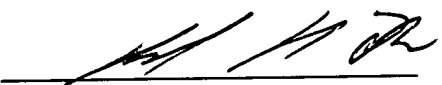
The requested extension and appropriate non-small-entity fee are as follows (check time period desired):

- | | |
|--|-------------|
| <input type="checkbox"/> One month (37 CFR 1.17(a)(1)) | \$ _____ |
| <input checked="" type="checkbox"/> Two months (37 CFR 1.17(a)(2)) | \$450 _____ |
| <input type="checkbox"/> Three months (37 CFR 1.17(a)(3)) | \$ _____ |
| <input type="checkbox"/> Four months (37 CFR 1.17(a)(4)) | \$ _____ |
| <input type="checkbox"/> Five months (37 CFR 1.17(a)(5)) | \$ _____ |

- ☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount shown above is reduced by one-half, and the resulting fee is: \$ _____
- ☐ A check in the amount of the fee is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-0359.

- I am the ☐ applicant/inventor
☐ assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96)
☒ attorney or agent of record.
☐ attorney or agent under 37 CFR 1.34(a).
Registration number if acting under 37 CFR 1.34(a) _____

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

2/3/2006
Date
Richard R. Batt
Reg. No. 43,485

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ Total of _____ forms are submitted.